

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DAVID G. SASUGA

Appeal No. 2004-0915
Application No. 09/919,469

ON BRIEF

Before STAAB, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-15, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a method of packaging edible seedlings for distribution and use by consumers in which plants are grown on a growing medium to a seedling stage in which the stems of the plants remain soft and edible (specification,

page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Spencer	4,057,932	Nov. 15, 1977
Groth et al. (Groth)	4,742,644	May 10, 1988
Wareing et al. (Wareing)	4,790,105	Dec. 13, 1988
Graham et al. (Graham)	5,382,270	Jan. 17, 1995

The following rejections are before us for review.

Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Spencer.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Spencer in view of Graham.

Claims 4-11, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spencer in view of Wareing.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Spencer in view of Wareing and Graham.

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Spencer in view of Wareing and Groth.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 8 and 13) for the examiner's complete reasoning in

support of the rejections and to the brief and reply brief (Paper Nos. 12 and 14) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims,¹ to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

Spencer discloses a container for growing seedlings comprising two half sections connected together along their bottom margins by a hinge. Spencer discloses that, in use, the containers are “filled” with a growing medium, watered, allowed to settle and seeded. A mulch of sand or limestone grit is sprinkled to cover the seed and the containers are kept in a greenhouse for at least 8 weeks to allow the seeds to germinate. At any time during the seedling's growth, its root development may be inspected. This is done by opening the container like a book, removing the root plug from the container if desired for holding in the hand, inspecting the seedling and placing the root plug comprising the seedling root system within the compacted growing medium back into the container and closing the container like a book. When the seedling has developed to the point where it is large enough to transplant, the seedling

¹ The term “said” before “sidewall” in line 5 of claim 1 (Paper No. 4) should be deleted, as the first recitation of sidewall portions lacks antecedent basis in the claim. Likewise, “said” before “stems” in the penultimate line of claim 1 (Paper No. 4) should also be deleted.

in its container is moved to a semi-controlled outdoors area or unheated greenhouse to acclimatize or harden the seedling for outdoor conditions. See column 10, line 12, to column 11, line 14. Spencer also teaches that the disclosed containers are useful “for many kinds of plants, from trees to wild grasses, to shrubs, to vegetables” (column 12, lines 7-12).

Appellant argues that claim 1 is not anticipated by Spencer because (1) Spencer teaches packaging small trees for reforestation, not edible seedlings for distribution and use by consumers, as called for in appellant’s claim 1, (2) Spencer does not disclose growing plants on a growing medium and then placing said medium in said space in said tray, (3) Spencer does not disclose distribution of the seedlings to consumers while the plants are still in the seedling stage and (4) Spencer lacks disclosure of a predetermined height dimension as called for in claim 1 such that a top surface of the growing medium is “closely adjacent” to the upper edge surface of the tray when the medium is placed in the tray to allow easy snipping (brief, page 8).

With respect to argument (1), we note that Spencer’s teachings are clearly not limited to seedling trees for reforestation, inasmuch as Spencer teaches (column 12, lines 7-12) that the disclosed containers are useful “for many kinds of plants, from trees to wild grasses, to shrubs, to vegetation.” Moreover, while we recognize that appellant has defined “seedling stage” on page 2 of the specification as “a stage of development of the plants which follows and does not include the sprout stage and in which both the stems and leaves of the plants remain soft and edible,” we also observe, as has the

examiner (answer, page 5), that appellant's specification and claims do not specify by what species (e.g., humans only or animals generally) the seedlings are edible. With this in mind, we agree with the examiner that the plants discussed by Spencer are edible in their seedling stage and thus meet the limitations of claim 1.

With respect to argument (2), claim 1 does not require that the plants be grown to a seedling stage on the growing medium before said medium is placed in the space in the tray.² In any event, even if claim 1 were interpreted as requiring that the growing step be performed before the placing stage, Spencer discloses removing the growing medium (root plug) comprising the seedling root system from the container for inspection after the seeds have germinated into seedlings and placing the root plug with seedlings thereon back into the container, thereby meeting such sequence limitation.

As for argument (3), Spencer contemplates sales (distribution) to individual consumers (growers) for their use, which use may be growing, for example. See column 4, lines 47-49.

Finally, with respect to argument (4), while Spencer does not use the terminology "closely adjacent" or illustrate the growing medium or root plug within the container, Spencer does disclose that the containers are "filled with a growing medium" (column 10, line 18), which would leave one of ordinary skill in the art reading Spencer's disclosure with the impression that the container be filled substantially up to the upper

² Claim 1 does not specify that the steps be performed in the order or sequence in which they are recited in the claim and it is well established that limitations not appearing in the claims cannot be relied upon for patentability. In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

edge surface thereof with the growing medium. Moreover, Spencer teaches that ledges 53a, 54a “act as a standardizing level for screening off excess growing medium during the filling stage” (column 9, lines 51-53). As illustrated in Figure 10, these ledges, and hence the top surface of the growing medium, are closely adjacent the upper edge surface of the container. Accordingly, Spencer’s container, with the root plug therein, meets the “closely adjacent” limitation of claim 1.

For the foregoing reasons, appellant’s arguments fail to persuade us of any error on the part of the examiner in rejecting claim 1 as being anticipated by Spencer. The rejection is thus sustained.

The only arguments in appellant’s brief (see page 9) as to the patentability of claim 3 are the same as those discussed above with respect to claim 1. It should be apparent that we find these arguments as unpersuasive with respect to claim 3 and thus sustain the rejection of claim 3 as well.

The obviousness rejections

Turning next to the rejection of claim 2, which depends from claim 1 and further recites that the plants are culinary herbs, as being unpatentable over Spencer in view of Graham, appellant’s only argument is that Graham does not overcome the above-discussed alleged deficiencies of Spencer.³ In light of our discussion above, it should

³ Appellant does not challenge the examiner’s determination (final rejection, page 4) that Graham would have suggested the use of Spencer’s seedling packaging method for packaging culinary herbs.

be apparent that we find this argument unpersuasive of the nonobviousness of claim 2. We sustain this rejection.

The examiner has rejected claims 4-11, 14 and 15 as being unpatentable over Spencer in view of Wareing. We turn our attention first to claim 4. The examiner concedes that Spencer's container lacks a top portion having a top wall as called for in claim 4 but determines that it would have been obvious to provide a cover having a top wall as taught by Wareing "so as to provide protection to the seedlings to keep them away from outside influences that may harm the seedlings" (final rejection, page 5). Appellant has not disputed this determination, which appears reasonable on its face.

With respect to claim 4, appellant (brief, pages 9 and 10) argues that Spencer is directed to a method of growing seedlings for reforestation and does not disclose a method of packaging "edible seedlings for distribution to and use by consumers" (brief, page 9) and that Spencer lacks disclosure of placing the top surface of the growing medium closely adjacent to the upper surface of the container. Our discussion of these arguments, supra, with respect to claim 1 applies equally to claim 4.

Appellant additionally argues that Spencer does not disclose "growing plants on a growing medium to a seedling stage" and then 'placing said medium in [the] bottom portion of the container' and then 'closing said container, with said medium in said bottom portion, into [a] closed position'" (brief, page 10). We observe, at the outset, that claim 4 does not require that the recited steps be performed in the order in which they are recited. Moreover, even if claim 4 were interpreted as requiring that the

“placing” step follow the “growing” step and that the “closing” step follow the “placing” step, Spencer teaches inspecting the root plugs after the seeds have germinated to the seedling stage by opening the container, removing the root plugs, observing them, placing them back into the container and closing the container, thereby meeting the claim limitations at issue.

In light of the above, appellant’s arguments fail to persuade us of error on the part of the examiner in rejecting claim 4 as being unpatentable over Spencer in view of Wareing. This rejection is thus sustained.

The rejection is also sustained with respect to claims 7, 8, 10, 14 and 15. With respect to claim 7, the snap-fit cover arrangement taught by Wareing is a latch⁴ and appellant has not challenged the examiner’s determination that it would have been obvious to provide such a cover on Spencer’s container, as discussed above. With respect to claim 8, which calls for venting to allow the plants to have access to fresh air, Spencer’s container is provided with several openings, such as those formed in the region of the interfaces 53, 54 of the wall members 51, 52, as well as openings 22 which allow fresh air (for “Air-Pruning”) to reach the plants via the roots. Appellant’s arguments with respect to claims 10, 14 and 15 are the same as those advanced with respect to claim 4 and are unpersuasive for the reasons discussed above.

⁴ A “latch” is “a fastening for a window, etc.” (Webster’s New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

We shall not, however, sustain the rejection of claim 5 as being unpatentable over Spencer in view of Wareing. As pointed out by appellant on page 10 of the brief, Wareing discloses a “snap-fit” cover 10, not a hinged connection as called for in claim 5, and we find no suggestion in the either Spencer or Wareing to provide any other type of attachment of the cover to the container of Spencer. The examiner’s attempt on pages 4 and 5 of the final rejection to read the top and bottom portions of the container of claim 4 on the hingedly connected side portions of Spencer is untenable.

The rejection of claims 6 and 11, which depend from claim 5, rest in part on the examiner’s attempt to read the claimed top and bottom portions of the container on the hingedly connected side portions of Spencer’s container and likewise must fail. The rejection of these claims is thus also reversed.

Nor shall we sustain the rejection of claim 9 as being unpatentable over Spencer in view of Wareing. While Wareing teaches providing a gap in the shoulder 6 into which the flange 11 of the cover 10 is snap-fit to facilitate removal of the cover portion from the base section, this does not result in a gap between the cover and the base portion and, even if provided on Spencer’s container, would not result in such a gap. Quite simply, neither Spencer nor Wareing teaches or suggests providing such a gap at the interface of the cover and the container. As discussed above, the examiner’s attempt to read the top and bottom portions of claim 4 on the side portions of Spencer’s container and hence the recited “gap between said top portion and said bottom portion” on the gaps at the interface of shoulders 53 and 54 is unreasonable.

Claim 12, which depends from claim 4 and additionally recites that the plants are culinary herbs, is rejected as being unpatentable over Spencer in view of Wareing and Graham. Appellant does not dispute the examiner's determination that it would have been obvious to package culinary herbs using Spencer's method and, instead, merely reiterates arguments made with respect to claim 4. We find these arguments just as unpersuasive with respect to claim 12. It follows that we shall sustain the rejection of claim 12.

We shall not sustain the rejection of claim 13 as being unpatentable over Spencer in view of Wareing and Groth. Groth simply discloses a shipping container comprising a bottom supporting frame 12, a lower plant-containing frame 14, an upper plant-containing frame 16 and a cover member 18 disposed above the top frame 16. The top surface of each of the frames 12, 14 and 16 is provided with a peripheral groove 52, 60, 70 for receiving a lower tongue 50, 62, 68 of the respective frame or cover stacked above. Groth, in essence, teaches stacking a plurality of tray members and a single cover and provides no teaching or suggestion to provide the top wall (cover as modified in view of Wareing) and bottom wall of Spencer's container with complementary portions to facilitate stacking of the containers with their covers.

CONCLUSION

To summarize, the rejection of claims 1 and 3 under 35 U.S.C. § 102 as being anticipated by Spencer is sustained. The rejections of claim 2 as being unpatentable over Spencer in view of Graham and claim 12 as being unpatentable over Spencer in

view of Wareing and Graham are sustained, the rejection of claims 4-11, 14 and 15 as being unpatentable over Spencer in view of Wareing is sustained as to claims 4, 7, 8, 10, 14 and 15 and reversed as to claims 5, 6, 9 and 11 and the rejection of claim 13 as being unpatentable over Spencer in view of Wareing and Groth is reversed. The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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